

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK E. VERMURLEN

Appeal No. 1997-2397
Application No. 08/061,286

ON BRIEF

Before BARRETT, FLEMING, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-20, all of the claims pending in the present application.

The claimed invention relates to a process for converting black-and-white color separation information contained in PostScript™ software to a color separation which can drive a

color output device to print at least two different colors. More particularly, Appellant indicates at page 3 of the specification that the position of commands in the black-and-white software that define the color output for one color separation is determined, and the commands are changed to indicate that a color other than black is to be produced.

Claim 1 is illustrative of the invention and reads as follows:

1. A process for converting black-and-white color separation information contained in Post-Script software to color separation information which can drive a color output device to print at least two different colors, said process for converting black-and-white color separation information comprises determining positions of commands in the black-and-white software which define the color output for the information on one color separation, changing at least one of the commands to indicate that a color other than black is produced, and producing color output information that will effect trapping from said black-and-white color separation information when said color output device is driven to produce a color image.

The Examiner relies on the following prior art:

Geraci	5,029,115	Jul. 02, 1991
Nickell et al. (Nickell)	5,113,356	May 12, 1992
Dalrymple et al. (Dalrymple)	5,243,414	Sep. 07,

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1993
(Filed Jul. 29, 1991)

Claims 1-20 stand finally rejected under 35 U.S.C. § 103.
As evidence of obviousness, the Examiner offers Nickell in
view of Geraci with respect to claims 1, 2, 5, 13, 14, 19, and
20, adding Dalrymple to the basic combination with respect to
claims 3, 4, 6-12, and 15-18.

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Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-20. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

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837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).
In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential

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part

of complying with the burden of presenting a prima facie case
of

obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24
USPQ2d

1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 1, 2, 13, 19, and 20,
the Examiner, as the basis for the obviousness rejection,
proposes to modify (Answer, page 6) the black and white to
color conversion process of Nickell by relying on Geraci to
supply the missing teachings of converting black and white
color separation information to effect color trapping.

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In response, Appellant (Brief, pages 11-15) contends that, since the Examiner has not established proper motivation for combining Nickell and Geraci, a prima facie case of obviousness has not been established. After careful review of the Nickell and Geraci references in light of the arguments of record, we are in agreement with Appellant's position as stated in the Brief.

Our interpretation of the colorization process described by Nickell coincides with that of Appellant. In Nickell, a single page of color information is created from a black and white image by an indication of what areas of the black and white image are to be colored. In our view, the colorization process described by Nickell in which the manipulation of data in color separation files is never disclosed, has little relationship to a process in which data in separate color separation files are combined to produce a color image such as described in Geraci. It is our opinion that the Examiner has combined the general teachings of the black and white to color conversion system of Nickell with the trapping resultant color separation files conversion system of Geraci in some vague manner without specifically describing how the teachings would

be combined. This does not persuade us that one of ordinary skill in the art having the references before her or him, and using her or his own knowledge of the art, would have been put in possession of the claimed subject matter.

Further, we are cognizant of the Examiner's assertion (Answer, page 6) as to the conventionality of using color separation techniques for color printing. Notwithstanding the merits of this contention, however, we find no convincing reasoning supplied by the Examiner as to how and why the skilled artisan would apply such color separation teachings to the process described by Nickell. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). We are left to speculate why the skilled artisan would modify the color conversion system of Nickell with the color separation teachings of Geraci. The only reason we can discern is improper hindsight reconstruction of Appellant's claimed invention.

We have considered the Dalrymple reference which was

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applied by the Examiner solely to address the thermal transfer imaging features of several of the dependent claims. We find nothing, however, in Dalrymple which would overcome the innate deficiencies of the proposed combination of Nickell and Geraci discussed supra.

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Accordingly, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claims 1, 2, 13, 19, and 20, and claims 3-12 and 14-18 dependent thereon, cannot be sustained. Therefore, the decision of the Examiner rejecting claims 1-20 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge))
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

JFR:hh

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Mark A. Litman
3M Office of Intellectual Property Counsel
P.O. Box 33427
St. Paul, MN 55133-3427